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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/029,408      | 10/01/1998  | ANDREAS GERHARD BAAR | GEY-1020            | 6021             |

26418 7590 02/14/2002

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375 PARK AVENUE  
NEW YORK, NY 10152

EXAMINER

NOLAN, SANDRA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

DATE MAILED: 02/14/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/029,408

Applicant(s)

BAAR ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 243.

Disposition of Claims

- 4) ☒ Claim(s) 60-71 is/are pending in the application.
- 4a) Of the above claim(s) 65-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-64 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Claims***

1. Claims 60-71 are pending, with claims 65-70 withdrawn pursuant to the restriction requirement in the November 29, 2001 Office Action (Paper No. 18).

Accordingly, claims 60-65 and 71 are now under consideration.

### ***Rejection Withdrawn***

2. The 35 USC 112 rejection of claim 1[sic], which should have referred to claim 60, is withdrawn, in view of Applicants' amendment in the response of November 29, 2001 (Paper No. 18).
3. The 35 USC 103 rejection of claims 60-62 and 64 as unpatentable over Pommier et al (US 5039378) and Haas et al (US 5,576,049), as recited in section 9 of the December 8, 2000 Office Action (Paper No. 14) is withdrawn in view of the arguments presented in Paper No. 18.
4. The 35 USC 103 rejection of claims 60-63, now claims 60-63 and 71, as unpatentable over Pommier in view of Kharas et al (abstract of CA 2057669), as set out in section 10 of Paper No. 14, is withdrawn in view of the arguments presented in Paper No. 18.

### ***Rejections Maintained***

5. The 35 USC 103 rejection of claims 60-64, now claims 60-64 and 71, as unpatentable over Tiefenbacher et al (US 5,376,320) in view of Haas, as explained in section 11 of Paper No. 14, is maintained for reasons of record.

The selection of fibers of suitable length--per claim 71--is deemed a matter of design/engineering choice, depending upon the appearance and/or strength properties desired in the packaging body.

6. The 35 USC 103 rejection of claims 60-63, now claims 60-63 and 71, as unpatentable over Tiefenbacher in view of Kharas, as expressed in section 12 of Paper No. 14, is maintained for reasons of record.

The selection of fibers of suitable length--per claim 71--is deemed a matter of design/engineering choice, depending upon the appearance and/or strength properties desired in the packaging body.

### ***Response to Arguments***

7. Applicants' arguments filed in Paper No. 18 have been fully considered but they are not persuasive.

The arguments presented in Paper No. 18 will be responded to in the order in which they appear in that paper.

On pages 4-6 of Paper No. 18, Applicants argue that the Pommier process does not use the molding and baking operations required by the claims.

The Examiner concedes that Pommier fails to teach baking. However, to the extent that shaping (which Pommier does) can be considered molding, Pommier suggests molding.

Nonetheless, Pommier will not be discussed in detail because both rejections based on its teachings have been withdrawn.

On page 7 of Paper No. 18, Applicants argue that Tiefenbacher does not teach pre-formed substrates.

However, Tiefenbacher does teach that coatings of natural products having rubber-elastic properties may be used to cover Tiefenbacher's shaped bodies on one or both sides (col. 21, lines 13-17).

On page 7, Applicants also argue that the Tiefenbacher compositions must contain leavening agents, fats and lecithin.

However, Applicants' claims do not exclude these ingredients from their composites.

In the paragraph bridging pages 7 and 8 of Paper No. 18, Applicants argues that the fibers that Tiefenbacher uses may be plastic, glass or metal.

However, at col. 4, lines 25-28, Tiefenbacher also discloses "high-cellulose raw material . . . [such as] pulp". It is well known that cellulosic pulp is biodegradable.

On page 8, Applicants argue that Tiefenbacher never defines "ratable".

However, the examine takes official notice that "ratable" refers to things that can rot—i.e., things that are biodegradable.

On page 8, Applicants argue that Tiefenbacher's coating would not be biodegradable.

However, the title of Tiefenbacher's patent strongly suggests that he wanted his bodies to be "ratable", inferring that the use of non-biodegradable materials therein should be kept to a minimum.

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On page 8, Applicants argue that Haas contains nothing that makes Tiefenbacher relevant to their claims.

However, Haas states, at col. 11, lines 22-63, that cellulose acetate (col. 11, line 62) is among the group of coating polymers that are strong and water-insoluble (col. 11, line 22-23). Also, Haas shows that its coatings may be applied to preformed substrates (col. 11, lines 37-42), which preformed substrates are not shown in Tiefenbacher.

In other words, Haas supplies the water-insoluble coatings (i.e., applicants' liquid impenetrable boundary) and the treatment of preformed substrates.

Lastly, the examiner notes that, on page 9 of Paper No. 18, Applicants make only a passing reference to the rejection of claims 60-63 over Tiefenbacher in view of Kharas.

Nonetheless, the Examiner deems that rejection to proper for the reasons made of record in Paper No. 14.

### ***Final Rejection***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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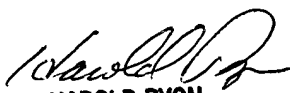
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Conclusion**

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.

SMN/smn  
February 9, 2002  
09029408(20)

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 2/12/02